

REMARKS

The Examiner in paragraph 1 of the Official Action objected to claims 3, 17, 18 and 33 for the reasons set forth therein. By this amendment applicants have made the corrections suggested by the Examiner. Accordingly, those objections are no longer applicable.

The Examiner also rejected claims 32-34 under 35 USC § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regards as the invention. In this regard, claim 32 has been rewritten to more clearly set forth the invention of this claim. In particular, claim 32 now sets forth the steps of locating and selecting at least one digital image supplied by a user and provided in said storage medium, and automatically forwarding to a user on said personal computer to a remote computer site upon a predetermined action being made by the user so that a product advertisement may be viewed by the user. It is respectfully submitted that claim 32 as currently set forth, clearly identifies that the user views the advertisement that is provided by the remote computer site.

With regard to claim 34, this claim has been cancelled. Accordingly, the rejection against this claim is no longer applicable.

The Examiner rejected claims 1, 7, 8, 12, and 14-16 under 35 USC § 102(b) as being anticipated by Small (US 5,791,991) for the reasons set forth therein. A problem with prior art advertisement such as the one illustrated in the Small reference, is that the images employed in the game do not hold a high degree of relevancy with any particular individual user and therefore lessens the interest of the user in participating. This lack of relevancy reduces the value of the promotional space to potential advertisers and the efficiency their intended message is received. The present invention increases the relevancy and value of the promotional space by utilized personal images supplied by the user into the playing structure of the game. In a software product according to the present invention a high degree of promotional efficiency is obtained by combining and playing of a computer game which incorporates the personal images with a sponsor's message. In the Small reference, the game matrix is mapped to respective customer product categories or category numbers. The category numbers for the match game map can be randomly or pseudo-randomly generated

by the CPU 2. (See col. 5, lines 10-13). Thus, it can be clearly seen that this is not directed to an image supply by the user but to some product categories supplied by the advertisers. Nowhere does it teach or suggest the use of personal images in playing of the game as taught and claimed by applicants. What is taught is the providing of particular product categories for playing of the game.

The Examiner also rejected claims 2, 10, 11, 13, (14, 15, alternatively), 17, 22, 23, 25-34 under 35 USC § 103(a) as being unpatentable over Small for the reasons set forth in paragraph 8. Independent claims 1 and 17 as amended, both include the limitation of locating and selecting at least one digital image supplied by a user and provided in a storage medium and using that image in the game. The Small reference as previously discussed does not teach either of these. In addition, these claims disclose providing the game in a storage media. As discussed in the "Detailed Description of the Invention" on page 4, the computer medium may take the form of a discreet media such as a compact disk, memory card, floppy disk, Laser card or maybe in the form transmitted from a remote source to a memory in a computer 20 via a network. Nowhere is it taught or suggested in Small providing the medium with the images and program as taught and claimed by applicants. The medium includes not only the software but also the personal images upon which the game is played. Upon playing of the game an automatic prestored message will be played or the consumer will be directed to a remote computer site. Clearly, this is not taught or suggested in Small nor is there any teaching or suggestion to do so.

With respect to independent claim 32, the images in a computer program will be run together on the same computer which automatically forwards the user to the remote computer site upon the occurrence of a predetermined action which allows viewing of the advertisement. Here again, this is not taught or suggestion as there is no indication that any personal image is used nor does it automatically forward the user to a remote computer site as taught and claimed by applicants.

In summary, applicants respectfully submits that the Small reference does not anticipate or teach or suggest the invention as set forth in the independent claims.

With regard to the other references cited, i.e. the Walker et al. and Force et al. references, the claims rejected therein depend at least ultimately upon independent claims which have been previously shown to be patentably distinct over the prior art. These references do not teach or suggest anything by themselves or in combination with Small which would render applicants' claims obvious.

In view of the foregoing applicants respectfully submits that the application is in condition for allowance and such action is respectfully requested.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page(s) is captioned **"Version with Markings to Show Changes Made"**.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Frank Pincelli', written over a horizontal line.

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Version With Markings to Show Changes Made

In the Specification:

The paragraph beginning on page 2, line 24 has been amended as set forth below:

- a. locating and selecting at least one digital image supplied by a user and provided in the storage medium;

The paragraph beginning on page 2, line 27 has been amended as set forth below:

- c. automatically displaying a prestored message to the user upon playing or completion of the game.

The paragraph beginning on page 3, line 3 has been amended as set forth below:

- a. locating and selecting at least one digital image supplied by a user and provided in a storage ~~media~~medium;

The paragraph beginning on page 3, line 6 has been amended as set forth below:

- c. automatically forwarding to the user to a remote computer site upon playing or completion of said game.

The paragraph beginning on page 3, line 12 has been amended as set forth below:

- a. locating and selecting at least one digital image supplied by a user and provided in said storage medium;

The paragraph beginning on page 3, line 14 has been deleted as set forth below:

~~_____ b. _____ providing product advertisement which will be automatically displayed upon a predetermined action; and~~

The paragraph beginning on page 3, line 16 has been amended as set forth below:

eb. automatically forwarding ~~the a user on a personal to a remote computer to a remote computer~~ site upon said a predetermined action so that said user can view a product advertisement.

In the Claims:

Claims 34-43 have been cancelled.

Claims 1, 3, 17, 18, 32 and 33 have been amended as set forth below:

Make sure you put in how many times amended.

1.(Once Amended) A computer software product comprising a computer readable storage medium having a computer program which when loaded into a personal computer causes the personal computer to perform the following steps:

- a. locating and selecting at least one digital image supplied by a user and provided in a said storage medium;
- b. incorporating said image in a game; and
- c. automatically displaying a prestored message to said user upon playing or completion of said game.

3.(Once Amended) A computer software product according to claim 1 wherein said computer software product includes a contest entry number that can be verified.

17.(Once Amended) A computer software product comprising a computer readable storage medium having a computer program which when

loaded into a personal computer causes the personal computer to perform the following steps:

- a. locating and selecting at least one digital image supplied by a user and provided in a storage medium;
- b. incorporating said image in a game; and
- c. automatically forwarding ~~to~~ the user to a remote computer site upon playing or completion of said game.

18.(Once Amended) A computer software product according to claim 17 wherein said computer software product includes a contest entry number that can be verified.

32.(Once Amended) A computer software product comprising a computer readable storage medium having a computer program which when loaded into a personal computer causes the personal computer to perform the following steps:

- a. locating and selecting at least one digital image supplied by a user and provided in said storage medium;
- ~~b. providing product advertisement which will be automatically displayed upon a predetermined action; and~~
- ~~eb.~~ automatically forwarding ~~the a user on said personal to a remote computer to a remote computer~~ site upon said a predetermined action so that said user can view a product advertisement.

33.(Once Amended) A computer software product according to claim 32 wherein said predetermined action comprises playing of a game.

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